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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,457	04/19/2004	Shinji Maekawa	0553-408	2984

7590 10/22/2007
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EXAMINER

PADGETT, MARIANNE L

ART UNIT	PAPER NUMBER
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1792

MAIL DATE	DELIVERY MODE
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10/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/827,457

Applicant(s)

MAEKAWA ET AL.

Examiner

Marianne L. Padgett

Art Unit

1792

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-7, 16-18 and 23-30.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.


**MARIANNE PADGETT
PRIMARY EXAMINER**

Continuation of 3. NOTE:

In claim 1, line 2, the proposed amendment to the "forming..." limitation does not make sense as written, hence would create 112 clarity problems, which is a new issue. Did applicants intend a meaning such as -- forming a liquid-repellent thin film, which is repellent to a liquid composition, on an insulating surface --? If so, such an amendment would clarify the "liquid-repellent" & liquid affinity" limitations of the claim with respect to the irradiating steps. However, the amendments in claims 1 & 2, which now read "a drop comprising the liquid composition" needs to be checked for support for the new scope, noting that as claimed the composition of the drop is not necessarily the same as the previously introduced "liquid composition", due to the "comprising" language that means the drop may contain other components besides the previously introduced liquid composition, thus may have different affinity &/or repellent characteristics. Also note that claims 3 & 16, whose nomenclature has not been changed, refer to the composition of the drop, which is not necessarily the liquid composition, such that these claims' options relationship to the treated & untreated areas may or may not be the same as that of the liquid composition.

Dependent claims 5+18+30, & 7+29, have not been amended to correspond to the proposed language for their independent claims 2 & 1, respectively, such that the "liquid" recited therein is not commenced or in scope with the "liquid composition" of the independent claims, creating a new clarity issue.

In independent claim 23, "a drop comprising the liquid composition" creates issues analogous to those discussed with respect to claims 1 & 2.

The examiner notes that the amendment to claim 25 is appropriate editing, the applicants may wish to consider also applying to claim 28.

The proposed necessary affinity & repellent relationships can be considered to create new issues in the claims, as they were not previously necessarily present, & the effect of these necessary relationships needs to be evaluated with respect to the various art rejections for the two different basic processes of either surface treatment or etching/groove formation to form the patterns.

Continuation of 11. does NOT place the application in condition for allowance because:

The proposed amendment creates new clarity issues which make its scope and meaning uncertain.

Also it is noted that while in their Remarks, applicants state that they have amended claims 6 to overcome the objection of section 2 of the action mailed 7/6/2007, the amendment discussed is not actually present.

The art rejections need to be further evaluated with respect to the proposed & probably intended new issues.

Continuation of 13. Other:

The examiner notes that the 10/8/2007 submission, as scanned into the PTO file, has a line across the entire width of the page on every single page submitted, that is approximately one third of the way down each page (same place on each), and while this does not cause any actual problems in the current submission, it may have the potential to do so in other submissions & the examiner does not know the cause of it, hence if it's an artifact of something on applicants' end, they may wish to see if they can do something to correct it or in the future prevent it from occurring.


10/18/2007